UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,063	01/14/2000	Ker Sze Toh	1662-15100(P99-2434)	7851

7590 10/14/2003		EXAMINER
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PO Box 3267	ART UNIT	PAPER NUMBER
Houston, TX 77253-3267	2132	3

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-19* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *14 January 2000* is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   Claims 1-19 have been examined.

Drawings

2.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference sign(s) not mentioned in the description:

72 (Fig. 3). A proposed drawing correction, corrected drawings, or amendment to the

specification to add the reference sign(s) in the description, are required in reply to the

Office action to avoid abandonment of the application. The objection to the drawings will

not be held in abeyance.

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: 20 (page 14, line 8) and 90 (page 17, line 22). A proposed drawing

correction or corrected drawings are required in reply to the Office action to avoid

abandonment of the application. The objection to the drawings will not be held in

abeyance.

4.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4)

because reference character "24" has been used to designate both the control module

and the software modules (page 11, lines 24-25). A proposed drawing correction or

corrected drawings are required in reply to the Office action to avoid abandonment of

the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-2, 5-7, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over O'Connor (U.S. Patent No. 5,894,571) in view of Arai (Japanese

Application No. JP 10-011282). For the Arai reference, the examiner relies on the

computer-generated translation version of the patent application. When the formal

translation arrives at the office, it will be mailed to the applicant.

a...   Referring to claim 1, O'Connor discloses a software installing system

comprising:

a digital storage device containing a control module (col. 6, lines 22-25,

30-31); software products (col. 5, lines 22-25); and a unique identifier assigned to all

software products (col. 6, lines 17-18);

a computer system having anticipated elements storing an identifier

corresponding to one assigned to the software products in the digital storage device

(col. 6, lines 14-15);

the control module loads the software products onto the computer system
if the identifier stored in the computer system matches the identifier assigned to the
software products (col. 6, lines 37-41).

O'Connor fails to teach a unique identifier is assigned to each software
product in the digital storage device and the use of a non-volatile memory of the
computer system to store the identifier.

Arai discloses a unique identifier is assigned to each software product in a
digital storage device (par. 0012). It would have been obvious to one of ordinary skill in
the art at the time the invention was made to modify the system of O'Connor such that a
unique identifier is assigned to each software product in the digital storage device as
suggested by Arai in order to achieve flexibility in controlling which software product to
download to the computer system.

The Arai reference also discloses the use of non-volatile memory of a
computer system to store identifiers corresponding to ones assigned to software
products in the storage device (par. 0013). It would have been obvious to one of
ordinary skill in the art at the time the invention was made to use non-volatile memory to
store the identifiers in the O'Connor system as suggested by Arai so that the identifiers
can be safely saved in the computer system.

b.   Referring to claim 2, Arai further discloses that the non-volatile memory
can be updated to store additional identifiers (par. 0021).

c.   Referring to claim 5, Arai further discloses means for updating the non-
volatile memory to include additional identifiers (par. 0018).

d.   Referring to claim 6, O'Connor further discloses a serial number stored in the computer system (col. 6, lines 11-12).

e.   Referring to claim 7, O'Connor does not disclose the use of the non-volatile memory of the computer system to store the serial number. It would been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to get the advantage of safely saving data in a computer system by storing the data in non-volatile memory. It would been obvious to one of ordinary skill in the art at the time the invention was made to store the serial number in the non-volatile memory of the computer system to get this advantage.

f.   Referring to claim 15, O'Connor further discloses a process for delivery of custom-ordered software products to a computer system having anticipated elements. The process comprises the steps of:

writing custom-ordered software products onto a digital storage device (col. 4, lines 46-49, col. 5, lines 21-25);

assigning a unique identifier to all custom-ordered software products in the digital storage device (col. 6, lines 17-18);

writing the identifier to an internal storage of the computer system (col. 6, lines 14-15, 37-40);

inserting the digital storage device into the computer system (col. 6, lines 29-31);

reading the identifier stored in the computer system (col. 6, lines 37-39);

comparing the retrieved identifier with one assigned to the custom-ordered software products (col. 6, lines 39-40);

installing the custom-ordered software products if the identifiers match (col. 6, lines 40-41);

O'Connor fails to teach assigning a unique identifier to each software product in the digital storage device and the use of a non-volatile memory of the computer system to store the identifier.

Arai discloses a system in which a unique identifier is assigned to each software product stored in a digital storage device (par. 0012). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of O'Connor such that a unique identifier is assigned to each software product in the digital storage device and written to the internal storage of the computer system in order to achieve flexibility in controlling which software product to download to the computer system.

The Arai reference also discloses the use of non-volatile memory of a computer system to store identifiers corresponding to ones assigned to software products in the storage device (par. 0013). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use non-volatile memory to store the identifiers in the O'Connor system as suggested by Arai so that the identifiers can be safely saved in the computer system.

g.   Referring to claim 17, O'Connor further discloses that the software products are tested before they are written onto the digital storage device (col. 4, lines 50-55).

h.   Referring to claim 19, O'Connor discloses a method for checking a serial number of the computer system to make sure that the software products intended for a certain computer system can only be installed to that computer system (col. 6, lines 9-12, 37-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to check the serial number of a computer system before writing the identifier of the software product into the non-volatile memory to make sure that the software product can only be installed to the designated computer system.

7.   Claims 3-4, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor in view of Arai as applied to claim 1 above, and further in view of Mullor et al. U.S. Patent No. 6,411,941.

a.   Referring to claim 3, O'Connor and Arai fail to teach the non-volatile memory of the computer system being read-only-memory. However, Mullor discloses a computer system having non-volatile memory being read-only-memory, resulting in data cannot be removed or modified (col. 5, lines 13-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of O'Connor and Arai to use read-only-memory as suggested by Mullor so that the identifiers cannot be removed or modified.

b.   Referring to claim 4, O'Connor and Arai do not disclose the content of the non-volatile memory is encrypted. However, Mullor discloses a computer system with the content of the non-volatile memory is encrypted, resulting in a stricter verification method (col. 5, lines 25-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of O'Connor and Arai such that the identifiers in the non-volatile memory is encrypted as suggested by Mullor in order to achieve a stricter verification method.

c.   Claim 18 is rejected on the same basis as claims 4 and 15.

8.   Claims 8-9, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor in view of Arai as applied to claim 1 above, and further in view of Beetcher et al. U.S. Patent No. 5,933,497.

a.   Referring to claim 8, it differs from claim 1 in that software modules are used in place of software products. Beetcher discloses a digital storage device containing software modules (col. 5, lines 41-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the digital storage device as suggested by Beetcher in the system O'Connor and Arai to achieve greater flexibility in packaging and downloading the software products.

b.   Claim 9 is rejected on the same basis as claims 2 and 8.

c.   Claim 12 is rejected on the same basis as claims 5 and 8.

d.   Claim 13 is rejected on the same basis as claims 6 and 8.

e.   Claim 14 is rejected on the same basis as claims 7 and 8.

9.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over

O'Connor, Arai and Mullor as applied to claim 3, and further in view of Beetcher. Claim

10 differs from claim 3 in that software modules are used in place of software products.

Beetcher discloses a digital storage device containing software modules (col. 5, lines

41-43). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the digital storage device as suggested by Beetcher in the

system O'Connor and Arai to achieve more flexibility in packaging and downloading the

software products.

10.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over

O'Connor, Arai and Mullor as applied to claim 4, and further in view of Beetcher. Claim

11 differs from claim 4 in that software modules are used in place of software products.

Beetcher discloses a digital storage device containing software modules (col. 5, lines

41-43). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the digital storage device as suggested by Beetcher in the

system O'Connor and Arai to achieve more flexibility in packaging and downloading the

software products.

11.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over

O'Connor in view of Arai as applied to claim 15 above, and further in view of Beetcher et

al. U.S. Patent No. 5,933,497. O'Connor and Arai fail to teach a set of software

products is written onto the digital storage device before the custom-ordered software products is ordered. However, Beetcher discloses method for writing software products onto a digital storage device before they are ordered by customers (col. 4, lines 39-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to write software products onto a digital storage device before they are ordered by customers as suggested by Beetcher in the system O'Connor and Arai so that the digital storage devices can be easily produced using mass production techniques before orders are placed.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Akiyama et al. U.S. Patent No. 6,067,640 discloses a system for management of software for limiting amount of use and number of backup copies of software.

Fink et al. U.S. Patent No. 5,953,533 discloses a computer software installation, distribution and maintenance method.

Gilley et al. U.S. Patent No. 5,771,287 discloses a method for secured control of feature set of a programmable device.

Katznelson U.S. Patent No. 5,010,571 discloses a system for controlling and accounting for retrieval of data from a CD-ROM.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 703-306-5617. The examiner can normally be reached on Mon - Fri: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Minh Dinh
Examiner
Art Unit 2132

md
October 6, 2003

GILBERTO BARRON
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